

REMARKS

I. Status of the Claims

Upon entry of this proposed amendment, claims 1-4 and 6-72 are currently pending in this application. Claims 1-52 have been rejected as being unpatentable under 35 U.S.C. § 103(a). Further to the restriction requirement dated July 15, 2005, claims 53-72 have been withdrawn as being directed to non-elected subject matter.

Claim 5 has been canceled, and claim 1 has been amended to include the limitations of claim 5. Support for the amended claim can be found generally in the originally filed claims and specification. More specifically, support can be found, for example, in the originally filed claim 5.

No new matter has been added by this proposed amendment nor does this amendment raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Moreover, all of the elements and their relationships now claimed were earlier claimed in the claims as examined, particularly claim 5 as originally filed. Therefore, this Amendment should allow for immediate action by the Office. The proposed amendments, moreover, place the claims in condition for allowance or, at least, in better form for appeal, if necessary.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner has maintained the rejection of claims 1-52 under 35 U.S.C. § 103(a) as being unpatentable over PCT Patent Publication WO 97/35457 ("*Tungare*") for the reasons disclosed on pages 3-4 of the final Office Action dated May 19, 2006, and on pages 2-4 of the Office Action dated September 26, 2005. Applicants

respectfully traverse this rejection for at least the reasons of record as well as for the following reasons.

In order to establish a prima facie case of obviousness, the Examiner must demonstrate that the prior art reference teaches all the present claim limitations, there would have been some suggestion or motivation, either in the cited reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings, and show a reasonable expectation of success. See M.P.E.P. § 2143. Both the teaching or suggestion to make the claimed combination, and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As argued previously, the rejection under §103 is fatally flawed because *Tungare* does not teach or suggest all of the claim elements, nor does it provide any motivation for the reference's modification to do so. For example, the Examiner has cited no disclosure in *Tungare*, nor do Applicants believe that any such disclosure exists, that would have provided the motivation for selecting a particle size and/or an amount of particle that is effective to reduce tackiness of the glass fiber product. Nevertheless, in order to further distinguish the invention recited in independent claim 1 from the prior art, claim 1 has been amended to recite that the particles have an average dimension ranging from 10 nm to 10 µm.

Nothing in *Tungare* teaches or suggests this average dimension. Moreover, nothing in *Tungare* teaches that the average dimension of the particles disclosed therein is a result-effective variable. Where the prior art has not recognized the "result-effective" capability of a particular invention parameter, in this case the average dimension of the particles, no expectation would exist that optimizing the parameter

would successfully yield the desired improvement. See, e.g., *In re Antonie*, 559 F.2d 618, 620, 195 U.S.P.Q. 6, 8-9 (C.C.P.A. 1977). The Court in *Antonie* also held that the claimed invention as a whole, including any improved properties, must be considered when the Office makes a determination of obviousness. *Id.* at 619, 195 U.S.P.Q. at 8.

In *Antonie*, the applicant claimed an apparatus for treating waste water. The apparatus included a tank having continuously rotating semi-immersed contactors (discs). *Antonie* discovered that the ratio of tank volume to contactor area of 0.12 gals./sq. ft. maximized the treatment capacity of the equipment.

The Office cited a single reference disclosing the same basic structure, but lacking any disclosure of a tank volume to contactor ratio of 0.12. Indeed, the reference did not suggest any reason to calculate the tank volume to contactor area ratio, much less to select a specific magnitude. The Office still considered an apparatus having the claimed ratio an obvious modification of the prior art apparatus. In the Office's view, optimizing efficiency by varying parameter magnitude represented a mere matter of mechanical experimentation.

Upon review, the C.C.P.A. reversed the Office, and stated that an evaluation of the obviousness of the invention as a whole requires looking "not only to the subject matter which is literally recited in the claim in question (i.e., the ratio value) but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification." *Id.* at 619, 195 U.S.P.Q. at 8. "In this case, the invention as a whole is the ratio value of 0.12 *and* its inherent and disclosed property." *Id.* The recognition by *Antonie* of the relationship between the result produced and the particular design parameters was the touchstone of nonobviousness in that case.

The holding in *Antonie* is directly applicable in the present case. There is no possible basis, according to the disclosure of the *Tungare*, for optimizing the particle size, for example, to achieve a reduction in tackiness. In Example 2 of *Tungare* the talc has a “maximum particle size of 20 μm .” This disclosure fails to provide any motivation for selecting particles having an average dimension within the claimed range of 10 nm to 10 μm . In fact, *Tungare* is silent as to whether the particle size should fall anywhere within the presently claimed average dimension range.

Rather, it is apparent that the only source of motivation for selecting the claimed particle size is the disclosure of the present application. However, as the Office is well aware, this constitutes impermissible hindsight. See M.P.E.P. §2142.

Therefore, absent clear and particular evidence of a motivation or desirability to modify *Tungare* to achieve the claimed particle size, a *prima facie* case of obviousness has not been and cannot be established.

CONCLUSION

In view of the foregoing amendment and remarks, Applicants respectfully request entry of the proposed Amendment, the reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response, and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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